



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,319	09/29/2000	Ernie F. Brickell	10559/329001/P9832	1992
20985 7590 06/20/2007 FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HENNING, MATTHEW T	
			ART UNIT 2131	PAPER NUMBER
			MAIL DATE 06/20/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.	Applicant(s)	
09/676,319	BRICKELL ET AL.	
Examiner	Art Unit	
Matthew T. Henning	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-46, 48-54, 56, 58-62 and 64-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-46, 48-54, 56, 58-62 and 64-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/17/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2131

1 This action is in response to the communication filed on 4/11/2007.

2 **DETAILED ACTION**

3 ***Response to Arguments***

4 Applicant's arguments with respect to claims 42-46, 48-54, 56, 58-62, and 64-70 have  
5 been considered but are moot in view of the new ground(s) of rejection.

6 Regarding applicants' argument that Saito did not teach providing information indicative  
7 of receipt of valid digital credential information from the relying party, the examiner does not  
8 find the argument persuasive. Saito teaches that when the certificate is valid, access control  
9 information of the user including ciphered user ID, password, and access level is transmitted  
10 from authentication server 2 to application server 6. Then when the application server verifies  
11 the access control information from the authentication server, an accept message is transmitted to  
12 the client. Because the access control information is not sent to the application server if unless  
13 the certificate was determined to be valid, the access control information is therefore "indicative"  
14 of a valid certificate. Similarly, the access control information is not verified by the application  
15 server if the certificate is not valid, and thus the client would not receive the accept message if  
16 the certificate was not valid. As such, the accept message is indicative that the certificate was  
17 valid. Therefore, the examiner does not find the argument persuasive.

18 All objections and rejections not presented below have been withdrawn.

19 Claims 42-46, 48-54, 56, 58-62, and 64-70 have been examined.

20 ***Information Disclosure Statement***

21 The information disclosure statement (IDS) submitted on 4/17/2007 was filed with the  
22 response to the non-final office action mailed 12/20/2006. The submission is in compliance with

Art Unit: 2131

1 the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being  
2 considered by the examiner.

### 3 *Specification*

4 The specification is objected to as failing to provide proper antecedent basis for the  
5 claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the  
6 following is required: In this case, the applicant has not pointed out support for a second relying  
7 party, as recited in claims 48, 56, and 64. Further, the examiner has been unable to find support  
8 for this limitation in the specification as originally filed. See the rejection of claims 48, 56, and  
9 64 under 35 USC 112 1<sup>st</sup> Paragraph below.

### 10 *Claim Objections*

11 Claim 62 is objected to because of the following informalities: Claim 62 recites "the  
12 authentication server" which lacks antecedent basis in the claim. It appears that this should have  
13 been amended to read "the authentication service", as was done to claims 58-65. Appropriate  
14 correction is required.

### 15 *Claim Rejections - 35 USC § 112*

16 The following is a quotation of the first paragraph of 35 U.S.C. 112:

17 The specification shall contain a written description of the invention, and of the manner and process of making  
18 and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it  
19 pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode  
20 contemplated by the inventor of carrying out his invention.  
21

22 Claim 48, 56, and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to  
23 comply with the written description requirement. The claim(s) contains subject matter which  
24 was not described in the specification in such a way as to reasonably convey to one skilled in the  
25 relevant art that the inventor(s), at the time the application was filed, had possession of the

Art Unit: 2131

1 claimed invention. In this case, the applicant has not pointed out support for a second relying  
2 party, as recited in claims 48, 56, and 64. Further, the examiner has been unable to find support  
3 for this limitation in the specification as originally filed. As such, the claims are rejected for  
4 failing to meet the written description requirement of 35 USC 112 1<sup>st</sup> Paragraph. The claims  
5 have been examined in view of the prior art below.

6 ***Claim Rejections - 35 USC § 103***

7 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
8 obviousness rejections set forth in this Office action:

9 *A patent may not be obtained though the invention is not identically disclosed or*  
10 *described as set forth in section 102 of this title, if the differences between the subject*  
11 *matter sought to be patented and the prior art are such that the subject matter as a*  
12 *whole would have been obvious at the time the invention was made to a person having*  
13 *ordinary skill in the art to which said subject matter pertains. Patentability shall not be*  
14 *negated by the manner in which the invention was made.*

15  
16 Claims 42-46, 48-54, 56, 58-62, and 64-70 are rejected under 35 U.S.C. 103(a) as being  
17 unpatentable over Anderson et al. (US Patent Number 6,021,202) hereinafter referred to as  
18 Anderson, and further in view of Saito et al. (US Patent Number 6,275,941) hereinafter referred  
19 to as Saito.

20 Regarding claims 42, 50, and 58, Anderson disclosed a machine-implemented method  
21 (See Anderson Fig. 26) comprising: relying on digital credential information (Signature and  
22 digital certificate) associated with a first user (Doctor 462) by a relying party (Third 468) (See  
23 Anderson Fig. 26 and Col. 39 Line 21 – Col. 40 Line 11); verifying that the digital credential  
24 information is valid using the professional license status information that has been stored for a  
25 plurality of users (See Anderson Col. 11 Paragraph 2); and providing information to the first  
26 user, the information indicative of receipt of valid digital credential information from the relying

Art Unit: 2131

1 party (See Anderson Col. 40 Lines 8-10 and Col. 24 Lines 38-50); wherein the relying party is  
2 distinct from the first user (See Anderson Fig. 26), but Anderson failed to disclose how to verify  
3 the digital credential information, or specifically an authentication service, which receives the  
4 credential information from a relying party, provides the verification information indicative of a  
5 valid professional license status of the first user from to the relying party; or provides the  
6 information indicative of receipt of valid digital credential information from the relying party.

7 Saito teaches a system for verifying digital credential information including digital  
8 certificates of a user (See Saito Fig. 5 and Col. 7 Lines 5-55) involving an authentication service  
9 (authentication server), receiving digital credential information (integrated certificate) associated  
10 with a first user (client) from a relying party (application server) (See Saito Col. 7 Lines 21-24);  
11 verifying the digital credential information associated with the first user to the relying party (See  
12 Saito Col. 7 Lines 25-36); providing verification information associated with the first user to the  
13 relying party (See Saito Col. 7 Lines 36-52); and providing information from the authentication  
14 service to the first user, the information indicative of receiving the digital credential information  
15 associated with the first user from the relying party (See Saito Col. 7 Lines 36 – Col. 8 Line 8).

16 It would have been obvious to the ordinary person skilled in the art at the time of  
17 invention to employ the teachings of Saito in the network prescription issuing system of  
18 Anderson by utilizing an authentication server as taught by Saito to verify the digital signatures,  
19 digital certificates, and license statuses of Anderson upon the request of one of the relying third  
20 parties. This would have been obvious because one of ordinary skill in the art would have been  
21 motivated to provide means for verifying this data as required by Anderson.

Art Unit: 2131

1           Regarding claims 43, 51, and 59, the combination of Anderson and Saito disclosed  
2     providing access to an activity log associated with the first user (See Anderson Col. 40 Lines 8-  
3     10 and Col. 24 Lines 38-50 and further see Saito Col. 8 Lines 3-5 and 36-44).

4           Regarding claims 44-45, 52-53, and 60-61, the combination of Anderson and Saito  
5     disclosed that the professional license status information comprises registration information  
6     indicative of a professional license registration status with a registration authority (See Anderson  
7     Col 11 Paragraph 2), and the method further comprises, prior to providing the verification  
8     information to the relying party, verifying the registration information with the registration  
9     authority (See Anderson Col. 11 Paragraph 2 and the rejection of claim 42 above).

10          Regarding claims 46, 54, and 62, the combination of Anderson and Saito disclosed  
11     storing access information associated with the relying party, the access information including  
12     information indicative of the providing the verification information (See Saito Col. 7 Lines 44-  
13     52); and providing the access information to the relying party (See Saito Col. 7 Lines 44-52).

14          Regarding claims 48, 56, and 64, the combination of Anderson and Saito disclosed  
15     providing information indicative of a failure to authenticate the digital credential information  
16     associated with the first user to a second relying party (See Saito Col. 7 Lines 36-38 and  
17     Anderson Fig. 26).

18          Regarding claims 49, and 65, the combination of Anderson and Saito disclosed at least  
19     one of the relying party and the authentication service issuing a challenge in response to  
20     receiving digital credential information associated with the first user (See Saito Col. 7 Lines 21-  
21     24).

Regarding claims 67-69, the combination of Anderson and Saito disclosed that the information is provided from the authentication service to the first user in response to receipt of the valid digital credential information from an unauthorized user (See Anderson Col. 27 Paragraph 4 wherein it is implied that not all of the uses of the signature card are necessarily legitimate and as such it is obvious that an unauthorized user could have used it to provide the signature credentials).

Regarding claim 70, the combination of Anderson and Saito disclosed that a relying party configured to receive the digital credential information associated with the first user and relay it to the authentication service (See Saito Col. 7 Lines 10-24 and the rejection of claim 42 above).

## Conclusion

Claims 42-46, 48-54, 56, 58-62, and 64-70 have been rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period



Art Unit: 2131


1 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37  
2 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,  
3 however, will the statutory period for reply expire later than SIX MONTHS from the mailing  
4 date of this final action.

5 Any inquiry concerning this communication or earlier communications from the  
6 examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.  
7 The examiner can normally be reached on M-F 8-4.

8 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
9 supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the  
10 organization where this application or proceeding is assigned is 571-273-8300.

11 Information regarding the status of an application may be obtained from the Patent  
12 Application Information Retrieval (PAIR) system. Status information for published applications  
13 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
14 applications is available through Private PAIR only. For more information about the PAIR  
15 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR  
16 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

17  
18  
19  
20  
21  
22  
23  
24  
25 /Matthew Henning/  
26 Assistant Examiner  
27 Art Unit 2131  
28 6/14/2007

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100